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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,474	07/23/2004	Takashi Yasukochi	KUZ-0019	4108

7590  
07/14/2005  
Licata & Tyrrell  
66 E. Main Street  
Marlton, NJ 08053

EXAMINER

CHOI, LING SIU

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/502,474	YASUKOCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ling-Siu Choi	1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*u*

### **DETAILED ACTION**

1. This Office Action is in response to the Amendment filed June 23, 2003. Claims 3 and 7 were canceled and claim 8 has been added. Claim rejections under 35 U.S.C. 102(b) as being anticipated by Tsubota et al. (US 5,049,417) are maintained.

#### ***Claim Objections***

2. Claim 8 is objected to because of the following informalities: Claim 8, line 2, "hydrophilic" is suggested to be changed to --hydrophilic--.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsubota et al. (US 5,049,417).

An adhesive	
a polymer	one or more kinds of acrylic or methacrylic monomer unit
	one or more kinds of monomer unit having a hydroxy group
wherein the polymer is crosslinked by a boron-containing compound and substantially no water is used in production of the adhesive	

(summary of claim 1)

Tsubota et al. disclose an acrylic adhesive which is obtained from the copolymerization of 2-ethylhexyl acrylate, ethyl acrylate, N-vinyl-2-pyrrolidone, **acrylic acid**, and **2-hydroxyethyl acrylic acid** (Examples 4-7 and 9). Tsubota et al. further disclose that “[f]or the adhesives having hydroxy groups such as 2-hydroxyethyl methacrylate, the following compounds are useful as crosslinking agents:....**boric acid**...”(col. 11, lines 21-32). Tsubota et al. furthermore disclose that the acrylic adhesive is applied to make an adhesive plaster used in the medical field (col. 1, lines 12-21). It is noted that the water containing a crosslinking agent is applied onto the adhesive layer for crosslinking adhesive material (col. 6, lines 33-51). **The amount of water left on the adhesive plaster would be trace.** It is noted that the recitation “substantially no water is used in production of the adhesive” is a processing step to produce the adhesive. And the present claims are drawn to a product. The case law held that “the patentability of a product does not depend on its method of production.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 96 (Fed. Cir. 1985). Thus, the present claims are anticipated by the disclosure of Tsubota et al.

***Response to the Amendment***

5. Applicant's arguments filed on June 23, 2005 have been fully considered but they are not persuasive.

Applicants: "The air-permeable adhesive tape of Tsubota et al. is produced by applying water drops on a layer of solution on a substrate wherein the solution contains an adhesive material and an organic solvent....Accordingly, use of water is clearly essential to the production of the air permeable adhesive tapes of Tsubota et al."

It is noted that the recitation "substantially no water is used in production of the adhesive" is a processing step to produce the adhesive. And the present claims are drawn to a product. The case law held that "the patentability of a product does not depend on its method of production." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 96 (Fed. Cir. 1985). The final product disclosed by Tsubota et al. is substantially identical to the product of the present invention because the free water remaining in the final product of Tsubota et al. is in a trace amount.

***Conclusion***

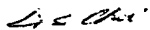
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1713

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.



**LING-SUI CHOI**  
**PRIMARY EXAMINER**

July 5, 2005